

REMARKS

CLAIM 36

Claim 36 is provided herein as amended and should address the Examiner's comment in the current Office Action.

35 USC 112

Claims 19-22, 24-25, 41-42, 51-52 and 76-77 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully disagrees.

The "comprising" or "includes" language in these dependent claims do not broaden the independent claims from which they depend. As an example, if claim 18 read as follows:

18. A material consisting of:
a first component, and
at least one second component.
19. The material of claim 18, wherein the at least one second component comprises a blue component.
20. The material of claim 19, wherein the blue component is teal.

In this example, the independent claim recites at least one second component.

Claim 19 does not broaden that recitation, because claim 19 states that the at least one second component comprises a blue component. Obviously, with the “at least one” language in claim 18, the second component may comprise two or more components. So, the fact that claim 19 states that one of the second components is a blue component does further narrow claim 18. Claim 20 narrows claim 19 by stating that the blue component is teal.

In the current claims, the previous example applies. Note that the claims are shown in their logical order for this example:

18. A planarization composition, consisting of:
an o-cresol-based polymer compound and a resol phenolic resin;
at least one surfactant; and
a solvent system.
76. The planarization composition of claim 18, wherein the solvent system consists of at least one alcohol and at least one ether acetate-based solvent.
20. The planarization composition of claim 76, wherein the at least one alcohol comprises a branched alcohol.

Note that claim 18 recites “a solvent system”. Claim 76 narrows that solvent system by reciting that the solvent system consists of at least one alcohol and at least one ether acetate-based solvent. Claim 20 does not broaden claim 18 or claim 76 at all – because it merely recites that “at least one alcohol” comprises a branched alcohol. The at least one alcohol can also comprise a methyl alcohol or another branched alcohol, but it must comprise a branched alcohol. It does not include other components that aren’t alcohols – obviously – so claim 20’s use of “comprising” cannot possibly broaden claim 76. The metes and bounds are not indefinite at all. The Applicant respectfully requests that the Examiner contact Dr. Thompson if there are additional questions.

35 USC §103

Claims 18-21, 24-27, 30-36, 41-42, 47-49, 51-55 and 76-77 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547).

Claims 18-22, 24-27, 30-36, 41-42, 47-49, 51-55 and 76-77 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547) in view of Hattori (US 6165676).

Claims 18-21, 24-27, 30-36, 41-42, 47-49, 51-55 and 76-77 are rejected under 35 USC 103(a) as obvious over Drage (US 5858547) in view of McCutcheon et al. (US 2007/0105384) or Patil et al (US 2003/0207209).

Claims 18-22, 24-25, 36, 41-42, 47-49, 51-52 and 76-77 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Hattori (US 6165676) and further in view of Miyamoto et al (US 6808857).

Claims 18-21, 24-25, 36, 41-42, 47-49, 51-52 and 76-77 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Drage (US 5858547) and further in view of Miyamoto et al (US 6808857).

The Applicant respectfully disagrees with all of these rejections.

The independent claims include the phrase "consisting of". MPEP Section 2111.03 states:

"The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.")"

Claim 18 recites: " A planarization composition, consisting of: an o-cresol-based polymer compound and a resol phenolic resin; at least one surfactant; and a solvent system."

Claim 36 contains similar provisions as the ones in Claim 18.

The Drage reference is cited against the claims in four out of the five rejections raised by the Examiner, including being the primary reference of rejection in three of the five rejections. The Drage reference is not applicable. The Examiner's contention that a resol-type phenolic resin is the same as the materials in Drage is simply not correct. Novolac resins and resol resins are part of the class of phenolic resins; however, they are not the same nor are their synthesis the same. Appendix A includes two different references showing the differences. The first reference is a description of these types of resins from Plenco. The second reference is from Juan Manuel Perez et al. that states on the first page: "There are two types of phenolic resins: resol and novolac." The article goes on to distinguish the two resins from one another. The Drage reference only refers to novolac resins and polymers – not resol resins. While both syntheses contain formaldehyde – they are different syntheses with different products.

Therefore, Drage is not suitable as a reference for this matter, because it only focuses on novolac resins and blends of novolac resins, but not blends of novolac resins with other resins. The Examiner has not pointed to any section in the Drage reference that contradicts this statement.

The other primary reference in these rejections is the FR 2801602. These components in FR 2801602 consist of catalysts based on sulfonic acid. The Examiner appears to be missing the point of the reference and at the same time applying it incorrectly to the current case. Regardless of which components are added to the resol-based resin or the catalyst in FR 2801602, there is no question that the final product is a combination of the resol-based resin and the catalyst based on sulfonic acid. There is

absolutely nothing in FR 2801602 that indicates that one of these components could be utilized separately before combination with the other. The entire reference is designed to describe the invention of combining resol-based resins and catalysts. So, there is absolutely no motivation or suggestion to one of ordinary skill in the art based on this reference to pull ½ of the product out and use it for something other than “consolidation of unstable ground for public road construction, mining, etc”.

The Examiner appears to be stating that merely mentioning part of a final product, wherein the entire final product includes other components and is used for road construction would lead one of ordinary skill in the art of planarizing materials to take that part of a final product and use it to produce thin films and other coatings on wafers. This position is simply not correct and should not carry forward into additional prosecution, if it is necessary.

The Hattori, McCutcheon, Miyamoto and Patil references do not cure the obvious deficiencies of Drage and/or FR 2801602, and therefore, claims 18 or 36 are allowable in this application. The remaining dependent claims are also allowable by virtue of their dependence on allowable claims 18 or 36.

CONCLUSION

The undersigned Attorney-of-Record respectfully requests an interview to resolve any remaining issues the Examiner has after review of this response, in order to avoid additional and lengthy written prosecution. Dr. Thompson is available during the week from 8AM to 4PM PST and can be reached at 949-224-6282. A request for an Interview is attached for the Examiner's immediate reference. It should only be considered if this application is not in immediate condition for allowance.

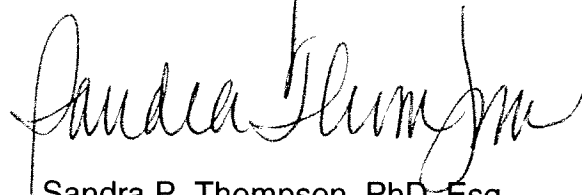
REQUEST FOR ALLOWANCE

Claims 18-22, 24-27, 30-36, 41-42, 47-49 and 51-56 and 77-78 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

Respectfully submitted,

Buchalter Nemer, A Professional Corp.

By:



Sandra P. Thompson, PhD, Esq.

Reg. No. 46,264

E-mail: sthompson@buchalter.com

Direct Line: 949-224-6282

Dated: April 26, 2010

ATTORNEYS FOR APPLICANT(S):

Buchalter Nemer, A Professional Corporation
18400 Von Karman Ave., Suite 800
Irvine, CA 92612
Fax: 949-224-6203